

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:  
Chuxin CHEN et al.

Serial No.: 10/689,370

Filed: October 20, 2003

For: Rule Based Capacity Management  
System for an Inter-Office Facility

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Confirmation No. 2855

Group Art Unit: 2863

Examiner: Sun, Xiugin

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January 23, 2008

Ellen Lovelace  
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**REPLY BRIEF**

**MAIL STOP APPEAL BRIEF - PATENTS**

Board of Patent Appeals and Interferences  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed October 30, 2007.

- (1) Real Party in Interest - Same**
- (2) Related Appeals and Interferences - Same**
- (3) Status of Claims - Same**
- (4) Status of Amendments After Final - Same**
- (5) Summary of Claimed Subject Matter - Same**
- (6) Grounds of Rejection To Be Reviewed On Appeal - Same**
- (7) Claim Appendix - Same**

**(8) Evidence Relied Upon – Same**

**REPLY TO EXAMINER'S RESPONSE TO APPELLANTS' ARGUMENTS**

**A. Claim 1 is allowable over Kekic and Sampath**

Appellants maintain their position that claim 1 recites features that are not rendered obvious by the combination of Kekic and Sampath. MPEP § 2143.03 states that "'[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." However, in the present matter, the Examiner has not shown that all words in the claim have been considered. In particular, the feature:

*a program for creating one or more analytical reports about the monitor set based on the rules and the data, wherein the one or more analytical reports include a prediction of exhaustion of the equipment, wherein the program includes:*

*an inference engine having instructions for . . . firing the rule on the data to produce an analysis and to create the one or more analytical reports*

is neither taught nor suggested by the combination of Kekic and Sampath.

In the "Response to Argument" section beginning on page 22 of the Examiner's Answer, the Examiner states that Appellants' arguments with respect to claim 1 are not persuasive. In particular, the Examiner once again acknowledges that Kekic does not disclose a program for creating one or more analytical reports, maintaining that Sampath remedies the deficiencies of Kekic in this regard. However, the Examiner fails to address Appellants' argument that the portions of Sampath that have been cited by the Examiner as teaching "a program for creating one or more analytical reports about a monitor set based on the rules and data related to the monitor set . . ." (column 6, lines 29-46 and column 9, lines 4-30) clearly fail to do so and merely comprise a laundry list of data values that can flow between one or more of the electronic systems of Sampath. Again, Appellants submit, and the Examiner has not disproved, that none of these data values mentioned in the cited passages of Sampath constitutes an "analytical report" within the context of claim 1.

Additionally, Appellants respectfully traverse the Examiner's position that "[a] review of the instant disclosure does not relay a specific alternate definition" to the term "equipment exhaustion." Appellants submit that, as noted in the Appeal Brief, the specifications of both the Appellants' application and the Sampath patent are instructive as to the difference between "equipment exhaustion," as recited in the claims, and "equipment failure," as addressed in Sampath. In particular, the focus of Sampath is on detecting and/or predicting the failure of equipment so as to enable remedial or preventive measures to be undertaken. In contrast, the focus of Appellants' application, as clearly recited in the claims, is on predicting exhaustion of equipment based on, for example, the natural lifetime of the equipment (e.g., claim 2) and/or the capacity of the equipment (e.g., claim 3). Although these limitations are not specifically recited in claim 1, they serve as evidence of the context in which the term "exhaustion" is consistently used throughout the Appellants' specification and claims. Clearly, the two terms are not analogous--"equipment failure" may occur without "equipment exhaustion" necessarily occurring. As a result, the portion of Sampath cited as teaching prediction of equipment exhaustion, which is the natural expiration of equipment due to usage, fails to do so.

In view of the fact that Sampath fails to remedy the acknowledged deficiencies of Kekic, as described above, it is apparent that, even when combined, the references do not teach the subject matter as claimed in independent claim 1; therefore, the subject rejection thereof should be reversed.

For the foregoing reasons, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness with respect to claim 1; therefore, the decision of the Examiner to reject independent claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Kekic and Sampath is erroneous and should be reversed.

**B. Claim 4 is allowable over Kekic, Jain, and Bergholm**

With regard to claim 4, the combination of references cited by the Examiner in rejecting this claim (i.e., Kekic, Jain, and Bergholm) is clearly improper. In *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), the Supreme Court stated that:

*a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to*

*their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.*

*Id.* at 1741 (emphasis added).

As the PTO recognizes in MPEP § 2142:

*The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.*

In the present case, even assuming *arguendo* that the Examiner can demonstrate that each element of claim 4 was independently known in the prior art, the Examiner has previously failed and continues in the Examiner's Answer to fail to identify a valid reason why a person of ordinary skill in art would have combined elements of the platform independent computer network management client taught by Kekic with elements of the customizable user interface for network navigation and management taught by Jain and elements of the apparatus for providing efficient use of telecommunications network resources taught by Bergholm in the manner recited in claim 4. As noted by the Supreme Court in *KSR*, "inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *KSR* at 1741. Therefore, while the present invention "rel[ies] upon building blocks long since uncovered," the Examiner continues merely to demonstrate that each of claim elements was, independently, known in the prior art and then to improperly conclude that the combination of the references that independently disclose those elements is proper.

As previously noted, in the present case it is clear that the Examiner's combination arises solely from hindsight based on the claimed invention without any showing of a valid reason why a person of ordinary skill in the art would have combined the elements independently taught by the cited references. For example, on page 26 of the Examiner's Answer the Examiner states that:

*it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the teaching of the Bergholm inventory system in the Kekic system in order to monitor the network equipments [sic] located in*

*various control pointes [sic] more efficiently, as motivated by Bergholm [at column 1, lines 15-27].*

The cited portion of Bergholm states that:

*The complexity of designing, building, and maintaining networks is well known. Telecommunications networks can be created from various pieces of equipment. This equipment can be located in various control points referred to as offices. Each office can contain its own inventory of equipment. Thus, there is a need to monitor or control the inventory in the various office locations throughout the network. In addition, there is a need to design links between offices in the network so as to provide different services throughout the network. Finally, there is also a need to provide orders for service adaptations, either service enhancements in the network or the removal or replacement of services.*

The cited text is concerned with monitoring equipment at different control points; therefore, even assuming *arguendo* that Bergholm teaches obtaining equipment related data using a separate inventory system, as asserted by the Examiner, the cited text of Bergholm clearly fails to provide a motivation for combining such teaching with the system of Kekic.

As noted by the Supreme Court in *KSR*, "inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 1741. Therefore, while the present invention "rel[ies] upon building blocks long since uncovered," the Examiner continues merely to demonstrate that each of claim elements was, independently, known in the prior art and then to improperly conclude that the combination of the references that independently disclose those elements is proper.

For the foregoing reasons, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness with respect to claim 4; therefore, the decision of the Examiner to reject independent claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Kekic, Jain, and Bergholm is erroneous and should be reversed.

**C. Claim 10 is allowable over Kekic, Sampath, and Pisello**

**1. The Combination of References is Improper**

As noted above with reference to claim 4, in *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), the Supreme Court stated that:

*a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.*

*Id.* at 1741 (emphasis added).

In the present case, even assuming *arguendo* that the Examiner can demonstrate that each element of claim 10 was independently known in the prior art, the Examiner has previously failed and continues in the Examiner's Answer to fail to identify a valid reason why a person of ordinary skill in art would have combined elements of the platform independent computer network management client taught by Kekic with elements of the system for failure prediction, diagnosis and remediation using data acquisition and feedback for a distributed electronic system of Sampath and elements of the network management system having historical virtual catalog snapshots for overview of historic changes to files distributively stored across a network domain of Pisello in the manner recited in claim 10.

For example, on page 27 of the Examiner's Answer the Examiner states that:

*it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the teaching of [the] Pisello analytical report in the invention of Kekic in order to recognize a variety of current status problems and perform various trend analysis on said equipment, as motivated by Pisello [at column 17, lines 19-21].*

The cited portion of Pisello states that "[d]omain-wide studies can be used for recognizing a variety of current status problems and for performing various trend analysis functions." The cited text is concerned with trend analysis; therefore, even assuming *arguendo* that Pisello teaches "creating one or more analytical reports about a monitor set, wherein at least one of the analytical reports details a relationship between demand and capacity for at least a portion of the equipment," as asserted by the Examiner, the cited text of Pisello clearly fails to provide a motivation for combining such teaching with the system of Kekic.

As noted by the Supreme Court in *KSR*, "inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be

combinations of what, in some sense, is already known." *Id.* at 1741. Therefore, while the present invention "rel[ies] upon building blocks long since uncovered," the Examiner continues merely to demonstrate that each of claim elements was, independently, known in the prior art and then to improperly conclude that the combination of the references that independently disclose those elements is proper.

Therefore, for this mutually exclusive reason, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness with respect to claim 10; therefore, the decision of the Examiner to reject independent claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Kekic, Sampath, and Pisello is erroneous and should be reversed.

2. The Combination of References Does Not Teach the Claimed Subject Matter

Assuming *arguendo* that the combination of references is proper (which is clearly not the case, for at least the reasons discussed above), the combination cannot be applied to reject claim 10 under 35 U.S.C. § 103(a) because claim 10 recites features that are not rendered obvious by the combination of Kekic, Sampath, and Pisello. As previously noted, section 2143.03 of the MPEP requires that all words in a claim be considered in determining the whether that claim is patentable against the prior art. However, in the present matter, the Examiner has not shown that all words in the claim have been considered. Specifically, features:

*a plurality of rules related to the monitor set, wherein at least one rule enables a prediction of equipment exhaustion;*

and

*a program for creating one or more analytical reports about the monitor set based on the rules and the data, wherein at least one of the analytical reports details a relationship between demand and capacity for at least a portion of the equipment*

are neither taught nor suggested by the cited combination of references. In particular, as described above with reference to claim 1, the Examiner's characterization of the teachings of the references with respect to the cited elements is in error, and claim 10 is allowable over the cited combination of references for the same reasons as independent claim 1.

Therefore, for this mutually exclusive reason, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness with respect to claim 10; therefore, the decision

of the Examiner to reject independent claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Kekic, Sampath, and Pisello is erroneous and should be reversed.

D. Dependent claims 2, 3, 5-9, and 11-20

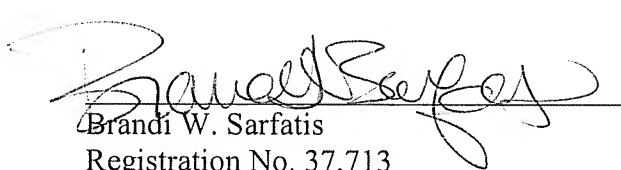
Dependent claims 2, 3, 5-9, and 11-20 depend from and further limit claims 1, 4, and 10 and are therefore allowable for at least the same reasons set forth above.

**Conclusion**

In view of the arguments set forth above and in the Appeal Brief, it is clear that the Examiner's Answer fails to establish a case for rejection of claims 1-20 under 35 U.S.C. §103(a). Accordingly, it is apparent that the rejection of claims 1-20 under 35 U.S.C. §103(a) is improper and should be reversed. A prompt notice of decision to that effect is earnestly solicited.

Respectfully submitted,

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